

REMARKS

Oath/Declaration:

In this Office Action, the Examiner objected to the Oath/Declaration as not identifying the post office address of each inventor. A copy of the Oath/Declaration previously mailed with the Office Action on July 23, 2001, which provides the post office address of each inventor, is enclosed with this Response.

In the Specification:

In this Office Action, the Examiner suggested that the specification contains numerous references to hyperlinks that are an improper incorporation by reference and consequently require deletion. However, Applicants assert that the hyperlinks in the specification (e.g., on page 11, line 5 and line 26, page 25, lines 13-16, and page 28) are not meant to incorporate subject matter by reference, but are included to comply with the requirements of 35 U.S.C. 112. This is consistent with MPEP 608.01:

Where the hyperlinks and/or other forms of browser-executable codes are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks.

Therefore, Applicants request a favorable reconsideration and respectfully request that the Examiner remove this objection.

Rejections Under Section 102(e):

In this Office Action, the Examiner rejected claims 1-3, 5-7, and 13 under 35 U.S.C. 102(e) as being anticipated by d'Eon et al., Pat. No. 6,006,197 (hereinafter d'Eon). Applicants, however, amended independent claims 1, 5, and 13 to more clearly point out and distinctly claim what the Applicants consider their invention. A marked-up copy of the amendment may be found in Appendix A.

Contrary to Applicants' claimed invention, the d'Eon reference discloses a system that correlates the number of impressions (i.e., clicks) of Web advertisements, and consequently requires that the user actually click on the advertisement before the effectiveness of the advertisements may be measured. The d'Eon reference fails to teach how the system disclosed therein could be adapted to provide information on advertisements by only viewing the advertisement without the step of clicking on an advertisement.

In particular, d'Eon reference fails to disclose collecting information in response to receiving the information to identify the advertisements received. Rather, d'Eon discloses that in response to a user clicking on one of the banner advertisements, a network path name is invoked to hyperlink the user to a Web page. Thus, d'Eon does not disclose or suggest collecting information that identifies the advertisements received in response to receiving the information.

Therefore, Applicants respectfully request that the Examiner remove the 102(e) rejection and consequently Applicants' independent claims 1, 5, and 13 are allowable and dependent claims 2, 3, 6, and 7 are then allowable as depending from allowable claims.

Rejections Under Section 103(a):

Also in this Office Action, the Examiner rejected claims 4, 8, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over d'Eon in view of Kaiserswerth et al., Pat. No. 5,684,954 (hereinafter Kaiserswerth). The Examiner also rejected claims 9, 10, and 12 under 35 U.S.C. § 103(a) as being unpatentable over d'Eon in view of Marsh et al., Pat. No. 5,848,397 (hereinafter Marsh). Additionally, the Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over d'Eon in view of Marsh and further view of Kaiserswerth. Applicants respectfully traverse this rejection.

Marsh and/or Kaiserswerth do not address, suggest, or teach at least one of the limitations that d'Eon fails to disclose, namely neither reference discloses:

"collecting information in response to receiving the information to identify the advertisements received," as called for by claims 4 and 8;

"the second stored program when executed causes the computer to collect statistics on advertisements in response to receiving information retrieved from the distributed network," as called for by claims 9-12; or

"deriving a unique identifier identifying the advertising message in response to receiving the advertising image," as called for by claims 14-16.

Because d'Eon, taken separately, or in view of Marsh and/or Kaiserswerth, do not teach or suggest all of Applicants' claim limitations, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection is removed.

CONCLUSION

Applicants, therefore, respectfully submit that all pending claims 1-16 are allowable and the indication of allowance is earnestly requested. Independent claims 1, 5, 9, and 13 are allowable for at least the reasons stated above and all of the dependent claims including claims 4, 8, 10-12, and 14-16 are dependent on allowable independent claims. Therefore, Applicants respectfully request favorable reconsideration.

If any questions or issues remain, the Examiner is invited to immediately contact the undersigned agent, Mark Triplett, at his direct dial number (312) 913-0001.

Respectfully submitted,

**McDONNELL BOEHNEN
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Date: 1/28/02

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APPENDIX A

Version with Markings to Show Changes Made

In the Claims:

1. (Amended) A method of providing information on advertisements viewed comprising:
 - a) instrumenting a viewing device with an instrumentation program;
 - b) receiving information at the viewing device, the information including advertisements; and
 - c) collecting information in response to receiving the information to identify [identifying] the advertisements received.
5. (Amended) A method of determining the reach and frequency of view of an advertisement comprising:
 - a) instrumenting a viewing device with an instrumentation program;
 - b) receiving information at the viewing device, the information including advertisements; and
 - c) collecting information in response to receiving the information to identify [identifying] the advertisements received.
9. (Amended) A panel computer comprising a first stored program for browsing a distributed network and a second stored program for instrumenting the computer to report information regarding the advertising images viewed on the computer, the computer comprising:
 - a) a first port coupled in communication with the distributed network;
 - b) a first storage area storing the first stored program, the first stored program when executed causing the computer to allow user controlled access to the distributed network; and
 - c) a second storage area storing the second stored program, the second stored program when executed causing the computer to collect statistics on advertisements in response to receiving information retrieved from the distributed network and viewed on the computer, the second stored program collecting information regarding the advertisements viewed.

13. (Amended) A method of collecting information regarding advertisements viewed by a client computer communicating with a distributed network, the method comprising the steps of:

- a) receiving an advertisement image from the distributed network at the client computer;
- b) deriving a unique identifier identifying the advertising message in response to receiving the advertising image; and
- c) reporting the unique identifier to an analysis engine.